

REMARKS

Claim Rejections – 35 USC § 103

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Lefebvre.

In figures 1-4, Lee discloses a pop-up dispenser (10) for dispensing sheets of aluminum foil, as described in column 1, lines 44-48. Each sheet has a lead portion and a trailing portion. The lead portion of the first sheet (30) of aluminum foil extends through a dispensing orifice (elongated opening 14) to an elevation above that of the dispensing unit (10), as shown in Figure 3. The trailing portion of the first foil (30) overlaps the lead portion of the next hair foil to be dispensed, as discussed in column 1, lines 10-19 and column 2, lines 48-51. Withdrawing the first sheet of foil (30) pulls the next sheet, as discussed in column 1, lines 19-23. The withdrawing of the first sheet of foil (30) can be achieved with one hand. The first foil sheet (30) can be applied to a person's hair immediately after being dispensed without any further preparation if the foil sheet is already the proper size for applying to hair. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the foil sheets dispensed by the dispenser of Lee 3.5 to 6 inches wide, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ (CCPA 1955).

Lee does not disclose the application of foil to a person's hair. Lefebvre discloses the application of foil to a person's hair as prior art in column 1, lines 11-40. It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the foil of Lee to a person's hair, as taught by Lefebvre, in order to highlight only selected strands of hair.

Note: According to MPEP 2111.02, the applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of the applicant's invention if the applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of."

Applicant has amended the claims from "consisting essentially of" to "consisting of". Therefore, applicant does not have to meet the above burden. As previously stated, Lee in view of Levbere does not teach the method steps as claimed and teaches additional steps. Therefore, the above claims are not obvious over the prior art.

The declaration under 37 CFR 1.132 filed 30 May 2006 is insufficient to overcome the rejection of claims based upon commercial success as set forth in the last Office action because: (1) Commercial success has not been established and (2) A nexus between the claimed invention and the alleged success has not been established.

MPEP 716.03(b) IV states, "Gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v.*

Genmark, Inc., 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988).” Here, the declaration only gives Product Club’s pop-up foil market share for its own market while ignoring the existence of any competitors.

Therefore, the declaration does not show this product’s place in the market.

What is the market share with respect to other companies selling foil sheets?

MPEP 716.03(b)I states, “Inventor’s opinion as to the purchaser’s reason for buying the product is insufficient to demonstrate a nexus between the sales and the claims invention.” In paragraph 9 of the declaration, the inventor makes statement that the alleged success of the pop-up foil product must be due to the method, since the method is what sets it apart from the prior art. There is no support for the assumption that the alleged success is due to the method, since other factors, such as advertising, could be the cause of the alleged success. Also, the declaration does not make a connection between the claimed method and the alleged success, since the declaration vaguely refers to “the method” and does not refer to specific claimed features. A nexus between the claimed invention and the alleged success has not been established.

The declaration does not show this product’s place in the market, that the product’s profitability is linked to the claimed invention, or that the profitability per unit is anything out of the ordinary in the industry involved.

Applicant has shown that the success is due to the claimed invention. In the prior art, roll foil, or pre-cut foil was used, dispensed and applied to the hair. The difference between the roll foil, the pre-cut foil, and the claimed invention, is what makes the claimed invention unique and gives it its commercial success. As stated in the previous declaration, Product Club had been selling roll foil and pre-cut foil. In the past, one had to cut the foil into appropriate lengths before applying it to the hair. The claims of the present invention add unique steps of removing a first sheet of hair from a pop-up dispenser, wherein the sheet has a width from about 3.5 to 6". The sheet has a lead portion and a trailing portion, the lead portion extending through a dispensing orifice to an elevation above that of the dispensing unit. The trailing portion overlaps the lead portion of the next foil sheet to be dispensed. The user pulls the next foil sheet through the orifice by withdrawing the first sheet of hair foil. The withdrawn foil is then applied to a person's hair. Previously, a sheet of hair foil would be cut to the appropriate length and then placed in a person's hair. It is these additional steps described in the claims that give the commercial success of the product. These facts are supported by the previous Declaration of Eric Polesuk.

Further, the Examiner states that the Declaration vaguely refers to the method and not to the claimed features. Paragraph 4 of Eric Polesuk's Declaration takes the exact elements from Claim 9.

Further, the previous Declaration does describe the commercial success of Product Club's roll foil and pre-cut foil in relation to its pop-up foil, and it gives the time frames associated with both.

Applicant believes that the application is now in condition for allowance.

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for Patents, P.O. Box 1450, Alexandria, VA 22313 on
December 29, 2006

Signature:

Name: Debbie Broderick

Respectfully submitted,

Philip M. Weiss

Reg. No. 34,751

Attorney for Applicant

Weiss & Weiss

300 Old Country Rd., Ste. 251

Mineola, NY 11501

(516) 739-1500